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10/825,836	04/17/2004	Wade C. Horton	HORTON-PA-1	8772
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OBER / KALER c/o Royal W. Craig 120 East Baltimore Street Baltimore, MD 21202			EXAMINER FIGUEROA, ADRIANA	
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Please find below and/or attached an Office communication concerning this application or proceeding.

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/825,836
Filing Date: April 17, 2004
Appellant(s): HORTON, WADE C.

Royal W. Craig
For Appellant

EXAMINER'S ANSWER

(1) Real Party in Interest

The examiner has no comment on the statement, or lack of statement, identifying by name the real party in interest in the brief.

This is in response to the appeal brief filed 12/07/2010 appealing from the Office action mailed 07/07/2010.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The following is a list of claims that are rejected and pending in the application:

1-4, 6, 8-11, 13, 14.

(4) Status of Amendments After Final

The examiner has no comment on the appellant's statement of the status of amendments after final rejection contained in the brief.

(5) Summary of Claimed Subject Matter

The examiner has no comment on the summary of claimed subject matter contained in the brief.

(6) Grounds of Rejection to be Reviewed on Appeal

Every ground of rejection set forth in the Office action from which the appeal is taken (as modified by any advisory actions) is being maintained by the examiner except for the grounds of rejection (if any) listed under the subheading "WITHDRAWN

REJECTIONS.” New grounds of rejection (if any) are provided under the subheading “NEW GROUNDS OF REJECTION.”

Appellant's statement of the grounds of rejection to be reviewed on appeal did not include the rejection of claim 8 under 35 U.S.C. 112th first paragraph and did not present arguments for this rejection. As stated above, this rejection is being maintained.

Appellant's statement of the grounds of rejection regarding the rejection of claims 1-4, 8-11, 13 and 14 is incorrect. The claims are rejected under 35 U.S.C. 112 second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

(7) Claims Appendix

A substantially correct copy of appealed claims appears on pages 11-13 of the Appendix to the appellant's brief. Claim 13 appears amended, however, this amendment to claim 13 was entered on 04/09/2010.

(8) Evidence Relied Upon

3,697,742	BOBRICK	10-1972
4,800,239	HILL	1-1989
6,281,440	BALDWIN	8-2001
6,152,413	GRETZ	11-2000

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-4, 8-11, 11 and 14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "said rigid thin sheet having an outer edge defining a flat two-dimensional object-shape" in lines 8-9 and "the flat two-dimensional object-shaped outer edge" in line 15. Examiner contends that "the object-shaped outer edge" has three dimensions, length, width and thickness. Only images would truly be two dimensional. Even a sheet of paper has some thickness and is three dimensional.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

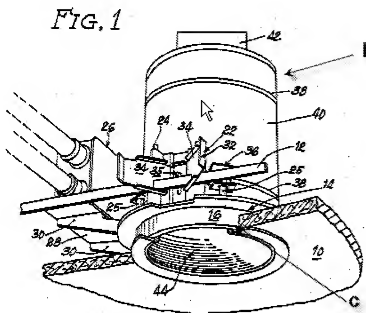
Claims 1-3, 6, 9, 10, 13, 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bobrick (US 3,697,742) in view of Hill (US 4,800,239).

Regarding claim 1, as best understood, Bobrick discloses in combination with a ceiling (10) comprising a planar surface defined by opposing sides and having a circular cutout (c) there through, a recessed lighting fixture (I) mounted on one side of said planar surface over said cutout and conforming thereto, (annotated Fig 1), and a finishing ring (46) defined by an aperture conforming to said cutout, said finishing ring being mounted on another side of said planar surface around said cutout and attached to the recessed lighting fixture (I) for providing a transition from said planar surface to said recessed lighting fixture, (Fig 1, Fig 5), but does not disclose an accent frame comprising a rigid thin sheet of material said rigid thin sheet having an outer edge defining a flat two-dimensional object-shape larger in diameter than a finishing ring, and a circular inner edge defining an aperture conforming to said cutout, and having an annular lip circumscribing said aperture for proper positioning with said cutout, said accent frame being sandwiched between said finishing ring and planar surface and maintained in place there between by the pressure of said finishing ring being retained to said recessed lighting fixture; the flat two-dimensional object-shaped outer edge of said accent frame protruding beyond said finishing ring and serves as an aesthetically pleasing backdrop to said finishing ring, serving to cover up any imperfections in the finish or cut of the surrounding planar surface.

However, Hill teaches an accent frame(10) comprising a rigid thin sheet of material said rigid thin sheet having an outer edge (e) defining "as best understood" a

flat two-dimensional object-shape larger in diameter than a finishing ring (5), and an inner edge (c) defining an aperture conforming to a cutout, and having an annular lip (l) circumscribing said aperture; said accent frame (10) being sandwiched between said finishing ring (5) and a planar surface and maintained in place there between by the pressure of said finishing ring being retained to the switch plate, (Fig 4); the flat two-dimensional object-shaped outer edge (e) of said accent frame (10) protruding beyond said finishing ring (5) and serves as an aesthetically pleasing backdrop to said finishing ring, serving to cover up any imperfections in the finish or cut of the surrounding planar surface, (Fig 1, 2, 4). Therefore, it would have been obvious to a person having ordinary skill in the arts at the time of the applicant's invention to modify the lighting fixture assembly of Bobrick to include an accent frame as taught by Hill in order to provide an ornamental appearance and to enhance the general appearance of the lighting fixture assembly.

It would have been an obvious matter of design choice to modify the rigid thin sheet of material to have the inner edge defining a circular aperture, since such a modification would have involved a mere change in the shape of the component and would provide accent frames that can be used in the circular cutout of Bobrick. A change in shape is generally recognized as being within the level of ordinary skill in the art. Further, one would not try to place a rectangular accent frame into the round opening of Bobrick. Those of ordinary skill in the art know that round pegs go in round holes.



Regarding claim 2, Bobrick modified by Hill discloses as discussed above. Hill further teaches the accent frame (10) having a decorative outer edge (e), (annotated Fig 1, 2).

Regarding claim 3, Bobrick modified by Hill discloses as discussed above. Hill further teaches the accent frame (10) being seated flush with said planar surface (p), (annotated Fig 4).

Regarding claim 6, Bobrick modified by Hill discloses as discussed above, but does not specifically teach that said thin sheet of material is approximately 1 mm thick. However, it would have been a matter of design choice to make the thin sheet approximately 1 mm thick, since such a modification would have involved a mere change in the size of the component and would provide a light weight sheet. A change

in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 220 F.2d 459, 105 USPQ 237 (CCPA 1955).

Regarding claim 9, Bobrick modified by Hill discloses as discussed in claim 1 Bobrick further teaches the planar surface being a ceiling (10), (Fig 1).

Regarding claim 10, Bobrick modified by Hill discloses as discussed in claim 1, but does not disclose said accent frame is constructed of a rigid material selected from the group consisting of wood, metal or plastic materials. However, it would have been a matter of design choice to construct the frame of wood, metal or plastic materials since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416. Further, all of the above materials would be obvious to use because they are all known to be easily shaped into a desired configuration.

Regarding claim 13, Bobrick modified by Hill discloses the basic claimed invention as discussed above. Hill further teaches the accent frame (10) is both decorative and is capable of covering up any imperfections in the edges of the cutout not covered by the finishing ring.

Regarding claim 14, Bobrick modified by Hill discloses the basic claimed invention as discussed in claim 1, but does not disclose the object-shape is a closed form selected from the group consisting of a star, flower or a house. However, it would have been an obvious matter of design choice to modify the object of Bobrick and Hill to have a shape of a star, flower or a house, since such a modification would have

involved a mere change in the shape of the component and would provide different decorative motives. A change in shape is generally recognized as being within the level of ordinary skill in the art. *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966). Further, the examiner contends that the shape of the device does not constitute a patentable feature. The shape of the device is purely for decorative

purposes.

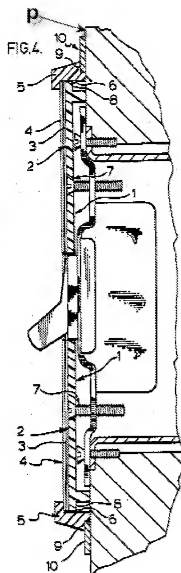
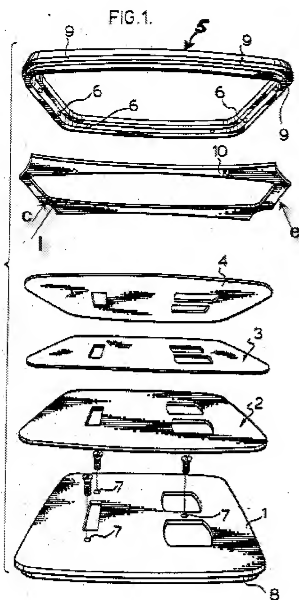
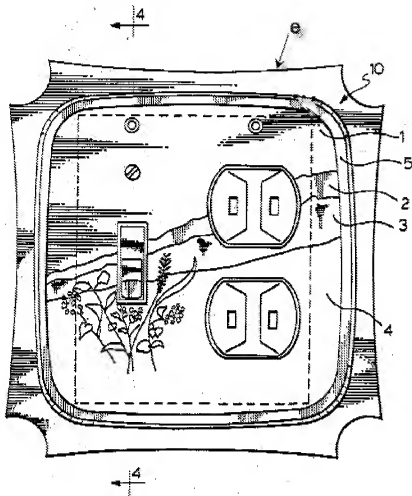


FIG. 2.



Claim 4, as best understood, is rejected under 35 U.S.C. 103(a) as being unpatentable over Bobrick (US 3,697,742) in view of Hill (US 4,800,239) and further in view of Baldwin (US 6,281,440). Bobrick modified by Hill discloses the basic claimed invention as discussed above, but does not disclose that the accent frame flares slightly away from the planar surface to provide an aesthetically pleasing depth or texture to the frame. However, Baldwin teaches an accent frame (11) that flares slightly away from the planar surface (23), (Fig 1, 3). Therefore, it would have been obvious to a person having

ordinary skill in the arts at the time of the applicant's invention to modify the accent frame of Bobrick and Hill to flare slightly away from the planar surface as taught by Baldwin in order to enhance the ornamental appearance of the frame.

Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bobrick (US 3,697,742) in view of Hill (US 4,800,239) and further in view of Gretz (US 6,152,413). Bobrick modified by Hill discloses the basic claimed invention as discussed in claim 1, but does not disclose said accent frame is formed by injection molding. However, Gretz discloses a frame (10) formed by injection molding (Column 4, Lines 56-60). Therefore, it would have been obvious to a person having ordinary skill in the arts at the time of the applicant's invention to modify the frame of Bobrick and Hill to be formed by injection molding as taught by Gretz in order to provide a stronger and flexible frame. The examiner would also like to point out that the injection molding limitation is a process limitation. Therefore, even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. Thus, even though Bobrick in view of Hill disclose the claimed invention, Gretz was further used to show that it is known to injection mold a frame.

GROUND OF REJECTION NOT ON REVIEW

The following grounds of rejection have not been withdrawn by the examiner, but they are not under review on appeal because they have not been presented for review in the appellant's brief.

Claim 8 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

In claim 8, the limitations "wherein said article is an electrical box with a screw mounted outlet or switch plate and wherein said frame is secured in place between the structure and the outlet or switch plate" present a conflict with the limitation in claim 1 of "a recessed lighting fixture" since the switch plate can not be a recessed lighting fixture at the same time. Thus, the embodiment claimed in claim 8 was not disclosed in the original disclosure and is therefore not enabled.

(10) Response to Argument

Appellant's arguments filed 12/07/2010 have been fully considered but they are not persuasive.

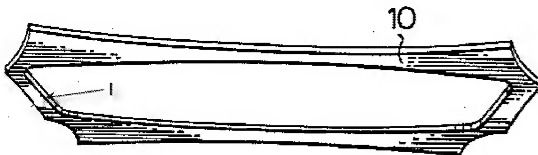
On page 6, section A of the brief appellant argues the rejection under 35 USC 112 second paragraph referring to the limitation in claim 1 of "said rigid thin sheet having an outer edge defining a flat two-dimensional object-shape" and "the flat two

dimensional object-shaped outer edge" appellant states that they are referring to the shape of the sheet. However, examiner would like to point out that the words of the claim must be given their plain meaning unless the plain meaning is inconsistent with the specification, MPEP 2111.01 [R-5]. The term "flat two dimensional object-shape" in claim 1 is considered to mean "having two dimensions." The term is indefinite because the specification does not clearly redefine the term. Examiner contends that "the rigid thin sheet" has three dimensions, length, width and a thickness that even if is sufficiently thin there is a thickness. Only images would truly be two dimensional. Even a sheet of paper has some thickness and is three dimensional. Thus the 112th second rejection is maintained.

On pages 7-8, section A of the brief appellant argues the rejection of claims 1-3, 6, 9, 10, 13 and 14 under Bobrick modified by Hill. Appellant argues that Hill does not disclose an annular lip. Examiner contends that Hill teaches an annular lip (I) as can be seen in the annotated Figure below with the lip of Hill indicated in the same manner as applicant's lip.

Examiner would like to note that the limitation "and protruding rearwardly there from for insertion into, seating within" was removed in the amendment to claim 1 filed on 04/09/2010 but applicant did not properly annotate the amendment and the examiner did not realize that it was deleted when the final office action was issued. Since the examiner did not realize that this language was deleted, because it was not properly indicated by applicant, the examiner inadvertently addressed said limitation in the final. However, this limitation was not addressed in the above rejection because it is no

longer in the claim. Thus, appellant's arguments regarding this limitation also no longer apply due to the fact that the limitations are no longer in the claim. Also, the examiner contends that the applicant's drawings do not show a lip that is any different than what is shown below by Hill at (I). For example, if one looks at applicant's figure 2, reference number 10 is indicating the lip of applicant's device. How is that lip 10 different from the lip (I) shown below? The examiner contends that both lips are the same.



On page 8, section B of the brief appellant argues that Hill does not disclose a flared edge as required by the limitations of claim 4. Examiner asserts that Baldwin was used to teach the limitations of claim 4. Baldwin in Figure 3 clearly shows the frame 11 having the outer surface 27 flaring away from the planar surface 23. In addition, examiner would like to note that the term "flare" is considered to be "a shape that spreads outward". Thus, the claimed limitations are met. In addition, the examiner would like to note that matters relating to ornamentation only which have no mechanical function cannot be relied upon to patentably distinguish the claimed invention from the prior art. Examiner contends that it would be obvious to modify the accent frame flare slightly away from the planar surface in order to enhance the ornamental appearance of the frame.

On page 9, section C of the brief appellant argues that "the accent frame of Hill is not capable of covering structural irregularities that may exist around the cutout". Examiner would like to point out that during examination, the claims must be interpreted as broadly as their terms reasonably allow. This means that the words of the claim must be given their plain meaning unless the plain meaning is inconsistent with the specification; MPEP 2111.01 [R-5]. The term "imperfections" is interpreted as any defect or flaw in the surface around the cutout. Examiner contends that the accent frame of Hill would cover any irregularities and imperfections around the edges of the cutout either structural or cosmetic due to the simple fact that the accent frame will extend from and cover the ceiling surface around the cutout in the same manner that applicant's accent frame extends from covers the ceiling surface around the cutout.

On page 9, section D of the brief appellant argues that "it would not be obvious to modify the accent frame of Bobrick and Hill to have a shape consisting of a star, flower or house". Examiner would like to note that matters relating to ornamentation only which have no mechanical function cannot be relied upon to patentably distinguish the claimed invention from the prior art. Examiner contends that it would be obvious to modify the accent frame to have any desired shape since such a modification would have involved a mere change in the shape of the component and would merely provide different decorative motives.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/ADRIANA FIGUEROA/

Examiner, Art Unit 3633

/Brian E. Glessner/

Supervisory Patent Examiner, Art Unit 3633

Conferees:

/Brian E. Glessner/

/B. E. G./

Supervisory Patent Examiner, Art Unit 3633

/MJ/ Marc Jimenez TQAS TC 3600